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IN THE
Supreme Court of the United States

October Term, 1948.

No. 372

LEROY J. LEISHMAN,

Petitioner,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Respondents.

BRIEF FOR RESPONDENTS.

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IN THE
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LEROY J. LEISHMAN,

Petitioner,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Respondents.

BRIEF FOR RESPONDENTS.

This is a patent infringement case and arose as the result of the filing by respondents of a complaint for declaratory judgment that claims 7 through 11 of Leishman Reissue Patent No. 20,827 are invalid, that respondents have not infringed any of said claims, and praying an injunction prohibiting petitioner from asserting that respondents infringe said reissue letters patent and from prosecuting actions in which devices manufactured by respondents are asserted to be infringements of the patent. The United States District Court for the Southern District of California, Central Division, on summary judgment, held the patent claims 7 through 11 not infringed by respondents and granted the injunction, limiting it, however, not to include the case of *Leishman v. The Richards and Conover Company*, Civil Action No. 2155 in the United States

District Court for the Western District of Oklahoma, and not to include the Galvin Manufacturing Company which assumed the defense in said case. The Galvin Manufacturing Company manufactured radio receiving sets embodying the herein accused devices manufactured by respondents, and The Richards and Conover Company sold such sets to others. The Court of Appeals affirmed the judgment of the District Court that said claims 7 through 11 were not infringed but modified the injunction to include the Galvin Manufacturing Company.

There is no conflict between the decision herein and the decision of any other court. The United States District Court for the Western District of Oklahoma had held the patent valid and infringed in *The Richards and Conover* case, *supra*, but since the filing of the petition for writ of certiorari in the instant case, the Court of Appeals for the Tenth Circuit, on November 15, 1948, reversed such holding and held the patent invalid for lack of invention and as anticipated by the prior art. This decision, *The Richards and Conover Company v. LeRoy J. Leishman*, Appeal No. 3577, has not been reported, but a true copy of same appears in the Appendix.

The findings of fact, conclusions of law, and judgment of the District Court in the instant case are found in the record at pages 86-96. An amendment to the judgment excluding the Oklahoma case and the Galvin Manufacturing Company from the injunction is found at page 134. The opinion of the Court of Appeals is found at pages 258-266, and its decree at pages 267-268.

In this case, petitioner relies upon Rule 38(5b) of the Rules of the Supreme Court, but it is submitted that the instant case presents no reason or grounds for the grant of certiorari such as is required by the rule. The reversal of the Oklahoma case by the Court of Appeals for the Tenth Circuit and the holding of invalidity there remove any possible conflict that might be urged by petitioner in the instant case. The decisions of the Court of Appeals for the Ninth Circuit and of the District Court for the Southern District of California are concurrent and should not be disturbed. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 278, 64 S. Ct. 593, 88 L. Ed. 721, 724; *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, 62 S. Ct. 1179, 86 L. Ed. 1537, 1541.

Statement of the Case.

The patent in suit which issued August 15, 1938 [R. 167, Pltf. Ex. F] is a reissue of patent No. 2,108,538 granted February 15, 1938 [R. 173, Pltf. Ex. H]. Litigation concerning the patent in suit commenced September 12, 1938, in the filing by petitioner of an infringement suit based on claims 7 through 11 of the patent against Associated Wholesale Electric Co. in the District Court for the Southern District of California, Central Division. In that case radio tuners admittedly the same patentwise as the accused tuners of respondents were charged to be infringements of the patent. The District Court, in *Leishman v. Associated Wholesale Elec-*

tric Co., 36 Fed. Supp. 804, held the claims in issue invalid as lacking invention. Petitioner appealed from that decision and on August 11, 1943, in *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, the Court of Appeals for the Ninth Circuit held said claims 7 through 11 not infringed, basing its decision on the ground that the face of the original patent 2,108,538 shows no intention to cover and secure as the patented invention tuner combinations not including levers. The court therefore held that the reissue claims in issue must be restricted to levers or else be invalid as for a different invention than the original patent. Since the accused tuners, as do respondents' tuners, contained no levers but rather plungers, they did not infringe. Application for writ of certiorari was made to this Court following that decision, and the petition denied. *Leishman v. Associated Wholesale Electric Co.*, 320 U. S. 794, 64 S. Ct. 261, 88 L. Ed. 478.

Two years after the aforesaid decision of the Court of Appeals for the Ninth Circuit, petitioner brought an action for the infringement of the same claims 7, 8, 9, 10 and 11 in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155, against The Richards and Conover Company, a distributor of radio sets manufactured by the Galvin Manufacturing Corporation of Chicago, Illinois, which incorporated the radio tuners of respondents accused herein. These tuners were the same patentwise as those involved in the *Associated Wholesale Electric Co.* case, *supra*. Thereafter, respondents, whose tuners were involved in the Oklahoma litiga-

tion, filed this suit for a declaratory judgment in the District Court for the Southern District of California, the residence of petitioner, and, after answer by petitioner, moved for summary judgment of noninfringement on the ground that the District Court was bound by the prior decision of the Court of Appeals for the Ninth Circuit in *Leishman v. Associated Wholesale Electric Co.*, *supra* [R. 27]. Petitioner, in response to such motion, filed an affidavit [R. 46] and exhibits [R. 177-253] which petitioner contended would have changed the decision of the Court of Appeals had their content been before the court in the *Associated Wholesale Electric Co.* case, but the District Court granted the motion, finding that such asserted evidence could not have changed or affected the ruling of the Circuit Court of Appeals and that no genuine issue as to any material fact respecting the issue of infringement of the patent claims existed [Findings 18 and 19, R. 91]. Petitioner also moved to amend his answer [R. 63] and filed an affidavit [R. 69] showing that Eastern counsel for respondents loaned two models to counsel for The Richards and Conover Company to be used in the Oklahoma litigation. He asserted that such loaning constituted a participation and control by respondents in the Oklahoma case and that they were bound by the decision in that case. Such decision was rendered prior to the signing of the judgment by the District Court in California and held the patent valid and infringed. The District Court in California denied petitioner's motion to amend his answer [R. 133-134], adjudged the claims in issue not infringed [R.

94], and enjoined petitioner from asserting such infringement as to petitioner's devices [R. 98]. The judgment was amended, however, to exclude from the injunction the Oklahoma case and the Galvin Manufacturing Company [R. 133-134].

After the decision by the California District Court petitioner appealed to the Court of Appeals for the Ninth Circuit from the summary judgment, and respondents cross-appealed from that portion of the judgment excluding the Oklahoma case and the Galvin Manufacturing Company from the injunction. At the same time The Richards and Conover Company appealed to the Court of Appeals for the Tenth Circuit from the decision of the District Court of Oklahoma that the patent was valid and infringed. The Court of Appeals for the Ninth Circuit affirmed the summary judgment of the California court but modified said judgment to include the Galvin Manufacturing Company within the injunction. In its opinion [R. 258-266] the Court of Appeals reaffirmed its holding in the *Associated Wholesale Electric Co.* case, *supra*, held that the asserted new evidence presented by Leishman in his affidavit would not have changed the decision in the *Associated Wholesale Electric Co.* case, and found the District Court bound by that decision. Thereafter and following the filing of the instant petition for certiorari, the Court of Appeals for the Tenth Circuit reversed the Oklahoma District Court and held the patent invalid (Appendix).

ARGUMENT.

In view of the concurrent findings of the courts below that the claims in suit are not infringed by petitioner; in view of the prior decisions of the District Court for the Southern District of California in *Leishman v. Associated Wholesale Electric Co.*, *supra*, wherein the re-issue claims in suit were held invalid as lacking in invention, and of the Court of Appeals for the Ninth Circuit in that case holding that the patent was not infringed by devices patentwise the same as the devices of respondent in the instant case; and in view of the recent decision of the Court of Appeals for the Tenth Circuit in *The Richards and Conover Company v. Leishman*, *supra*, wherein the patent was held invalid as lacking invention and as anticipated, it is submitted that this clearly is not a proper case for the grant of a writ of certiorari. This Court has announced that it will not ordinarily disturb concurrent decisions in patent cases where no conflict of decision exists. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 64 S. Ct. 593, 88 L. Ed. 721; *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, 62 S. Ct. 1179, 86 L. Ed. 1537; *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U. S. 175, 58 S. Ct. 849, 82 L. Ed. 1273; *Tennessee Coal I. & R. Co. v. Muscoda Local No. 123*, 321 U. S. 590, 64 S. Ct. 698, 88 L. Ed. 949.

The patent in suit has been litigated many times over and always unfavorably to the petitioner. The case presents no issue of paramount public interest, and a grant

of the instant petition for certiorari would accomplish nothing more than to encourage petitioner to continue in his fruitless litigation of a patent held invalid or not infringed in all cases where the question of its validity or infringement has been finally passed upon.

Questions Presented.

The petition in this cause is based upon six alleged questions. The first question presented is with reference to asserted equivalency between the levers of the patented combination and the plungers of respondents' device. Petitioner urges conflict between the Court of Appeals for the Ninth Circuit and the District Court for the Western District of Oklahoma on this issue. However, the District Court for the Western District of Oklahoma has been reversed by the Court of Appeals for the Tenth Circuit in *The Richards and Conover Company v. Leishman*, decided November 15, 1948 (Appendix), although in that case the instant patent is disposed of as invalid for lack of invention. The court there refers to *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, the decision upon which the instant case is based, and quotes therefrom to the effect that in the accused combination the plungers perform but a part only of the function performed by the levers of the patented combination and that the part so performed is not performed in the same way nor in substantially the same way, and that the plungers and levers are therefore not equivalents (Appendix p. 6).

Petitioner urges that the courts below erred in finding a lack of equivalency between the levers of the patented combination and the plungers of respondents' devices, stating that the functions of the two are identical and refer-

ring to various examples of plungers and levers and to copies of ten patents introduced below. Petitioner misconceives the holding of the Court of Appeals and the law of equivalency. The court below has merely held, first, that the claims in issue cannot be construed to cover plunger-operated devices lest the patent be for a different invention than was intended to be patented in and by the original patent No. 2,108,538 and hence invalid; and, second, that in the patented combination respondents' plungers perform but a part of the function of the levers in the patented combination and perform such part in a different way. This conclusion was arrived at after full trial in the *Associated Wholesale Electric Co.* case and was reaffirmed in the instant case after consideration of the asserted new evidence presented by petitioner. That plungers and levers may be equivalents under other circumstances and that plungers and levers are shown in the examples pointed out by petitioner and in the ten patents presented by petitioner is immaterial. As stated in Walker on Patents, Deller's Edition, Vol. 3, Section 470, page 1707:

"But one thing may be an equivalent of another in one environment, and not such an equivalent in another situation. * * * Springs and weights are generally equivalents * * *, but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents. * * *"

Question 2 asks whether it is proper for a federal court to grant a summary judgment in direct conflict on identical issues with the judgment of another federal court rendered after full trial. This question has become moot in view of the decision by the Court of Appeals for the Tenth

Circuit above discussed. As heretofore stated, that decision reversed the lower Oklahoma court. Moreover, as pointed out by the Court of Appeals for the Ninth Circuit in the instant case, the California District Court was bound by the decision in the earlier *Associated Wholesale Electric Co.* case and the now reversed decision of the Oklahoma court could have no effect upon it.

The third question presented refers to the propriety of granting summary judgment upon the basis of *stare decisis*. As stated by the Court of Appeals for the Ninth Circuit below, the propriety of granting summary judgment depends upon Rule 56 of the Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723, as it existed prior to March 19, 1948. Said rule is set forth [R. 261]:

“ ‘A party seeking to recover upon a claim * * * or to obtain a declaratory judgment may, at any time after the pleading in answer thereto has been served, move with or without supporting affidavits for a summary judgment in his favor;’ that ‘The adverse party * * * may serve opposing affidavits;’ and that ‘The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that * * * there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.’ ”

In accordance with said rule, respondents moved with supporting affidavits for summary judgment [R. 27-35]. Petitioner served an opposing affidavit presenting what petitioner urged was new evidence which would have changed the decision of the Court of Appeals in the *Asso-*

ciated *Wholesale Electric Co.* case had such evidence been before it then [R. 46]. The District Court reviewed this asserted new evidence and held that there was no genuine issue as to any material fact, and this holding was affirmed by the Court of Appeals. Clearly, respondents were entitled to judgment as a matter of law. Compelled by the reissue statute (Revised Statutes 4916, Title 35 U. S. C. Section 64) to conclude that the patent in suit must be restricted to a lever-operated device, the Court of Appeals had held in the *Associated Wholesale Electric Co.* case that plunger-operated tuners were not covered by the instant patent. No evidence appearing that could change that decision and respondents' tuners being the same as those accused in the *Associated Wholesale Electric Co.* case, respondents were entitled to judgment as a matter of law.

Question 4 raises the point as to whether it was proper for the Court of Appeals for the Ninth Circuit to enjoin petitioner from bringing suit based on the instant patent against the Galvin Manufacturing Company, respondents' customer. Such injunction is simply an application of the principle of *Kessler v. Eldred*, 206 U. S. 285, 27 S. Ct. 611, 51 L. Ed. 1065, which held that a decree in a patent suit in favor of a defendant manufacturer entitled that manufacturer to continue in the business of manufacturing and selling the hitherto accused devices throughout the United States without molestation by the patentee in the form of suits against the manufacturers' customers. The rule of law laid down in *Kessler v. Eldred* has never been questioned and has been uniformly adhered to and followed. Cf. *Toledo Scale Co. v. Computing Scale Co.*, 261 U. S. 399, 426, 43 S. Ct. 458, 67 L. Ed. 719, 730; *Steel-*

man v. All Continent Corp., 301 U. S. 278, 291, 57 S. Ct. 705, 81 L. Ed. 1085, 1093; *Commercial Acetylene Co. v. Avery Portable Lighting Co.*, 159 Fed. 935 (C. C. A. 7); *Goodyear T. & R. Co. v. Rubber Tire W. Co.*, 164 Fed. 869, 871; *Bryant Elec. Co. v. Marshall*, 169 Fed. 426, 430.

The fifth question argues that error was committed in the *Associated Wholesale Electric Co.* case, *supra*, in the failure of the Court of Appeals for the Ninth Circuit there to consider a disclaimed claim in arriving at what the original patent No. 2,108,538 intended as shown upon its face to have been covered and secured. The Court of Appeals for the Ninth Circuit in the *Associated Wholesale Electric Co.* case simply applied with respect to disclaimed claim 5 the well settled rule of law as laid down in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, 55 S. Ct. 455, 79 L. Ed. 1005, 1014, that a disclaimer "speaks from the date of the original patent," and therefore did not consider said disclaimed claim 5 in arriving at the evident intent of the patentee. This Court has had opportunity to review such holding of the Court of Appeals but denied the petition for writ of certiorari filed by petitioner after the *Associated Wholesale Electric Co.* case. *Leishman v. Associated Wholesale Electric Company*, 320 U. S. 794, 64 S. Ct. 261, 88 L. Ed. 478.

Finally, question 6 urges that the courts below erred in refusing to permit petitioner to amend his answer to the

complaint in order to make the additional defense that respondents were bound by the judgment in the Oklahoma case. Petitioner's proposed amended answer appears in the record at pages 72-86 and an affidavit in support of same appears in the record at pages 69-72. An opposing affidavit of Maxwell James, Eastern counsel for respondents, appears in the record at pages 66-68. Despite the allegation in the proposed amended answer that respondents participated in and jointly controlled the defense in the Oklahoma case, the affidavits both of petitioner and of Maxwell James clearly established that Maxwell James merely loaned to the attorney for The Richards and Conover Company two models of prior art devices. Clearly, such loaning did not constitute that privity or control necessary to create an estoppel by judgment. *Bigelow v. Old Dominion Copper Mining & Smelting Co.*, 225 U. S. 111, 32 S. Ct. 641, 56 L. Ed. 1009. The Court of Appeals below held in answer to petitioner's argument that he should have been permitted to file his supplemental answer that "even if the supplemental answer had been filed, still the pleadings, together with the affidavits, would have showed that there was no genuine issue as to any material fact and that Condenser and General were entitled to a judgment as a matter of law." [R. 264.] Lastly, even though petitioner were correct in his contentions, he could not profit thereby in view of the recent decision of the Court of Appeals for the Tenth Circuit reversing the holding of the District Court in Oklahoma.

Conclusion.

It is submitted that this case does not submit any sufficient reason for the grant of a writ of certiorari within the ruling and practice of this Court. This case involves merely concurrent decisions of the District Court and the Court of Appeals, and it presents no disputed issue of patent law nor principle conflicting with any applicable decision of this Court.

Respectfully submitted,

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LEONARD S. LYON, JR.,

Attorneys for Respondents.

MAXWELL JAMES,

Of Counsel.

APPENDIX

TABLE I

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APPENDIX.

TENTH CIRCUIT.

No. 3577—SEPTEMBER TERM, 1948.

THE RICHARDS AND CONOVER COMPANY, a corporation,

v/s.

LEROY J. LEISHMAN.

[November 15, 1948.]

Foorman L. Mueller (Josiah G. Holland on the brief) for appellant.

John Flam (J. B. Dudley on the brief) for appellee.

Before PHILLIPS, Chief Judge, and BRATTON and HUXMAN, Circuit Judges.

PHILLIPS, Chief Judge, delivered the opinion of the court.

Leishman brought this action against The Richards and Conover Company for alleged infringement of claims 7 to 11, inclusive,¹ of Reissue Patent No. 20827.

¹The claims in suit read:

"7. In combination with the tuning mechanism of a radio apparatus, of a rotatable rocker mounted upon a shaft operatively connected with said mechanism, said rocker having two arms each extending on a different side of said shaft; means adjustably movable about a pivot and acting upon bodily movement in one direction to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position; said rocker constructed so as to admit at least a portion of said means between said arms.

"8. The combination with the tuning mechanism of a radio apparatus, of a rotatable rocker mounted upon a shaft opera-

From a decree holding the claims in suit valid and infringed, The Richards and Conover Company has appealed.

The original patent was applied for December 15, 1934, and granted February 15, 1938. The reissue patent was applied for May 23, 1938, and granted August 16, 1938. The original patent contained six claims. The reissue patent contained the claims of the original patent and additional claims 7 to 12, inclusive.

tively connected with said mechanism, said rocker having two arms each extending on a different side of said shaft; means adjustably movable about a pivot and acting upon bodily movement in one direction to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position; the axis of said means being substantially co-axial with the axis of said rocker when said means is in engagement with both of said arms.

"9. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; and a manually movable operating means comprising an adjustably mounted positioning element adapted upon movement of said means in one direction to engage one shoulder of said rocker and rotate said rocker to a position at which the movement of said element is arrested by the collision of said element and the oppositely moving other shoulder of said rocker; said rocker constructed to permit at least a portion of said means to pass beyond a line connecting the points on said shoulders at which the shoulders are contacted by said means.

"10. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; a manually movable operating member; and a positioning element adjustably mounted on a pivot carried by said member; said element adapted upon movement of said member in one direction to engage one shoulder of said rocker and rotate said rocker to a position at which the movement of said rocker is arrested by the collision of said element and the oppositely moving other shoulder of said rocker; the axis of said element and the axis of said rocker being substantially

The patent is for an apparatus for turning rotatable rockers about their axis to predetermined positions.

The device of the patent is illustrated by Figures 1 and 2 of the patent drawing.

It will be noted that Figure 1 illustrates two rockers, 48 and 54. Claims 1 to 4, inclusive, 6 and 12 cover a device with two or more rotatable rockers. However, the claims in suit are limited to one rotatable rocker.

co-axial when said element is in engagement with both of said shoulders.

"11. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two arms lying on opposite sides of the axis of said rocker; a manually movable operating member; a positioning element adjustably mounted on a pivot carried by said member; said element adapted upon movement of said member in one direction to engage one arm of said rocker and rotate said rocker to a position at which the movement of said rocker is arrested by the collision of said element and the oppositely moving other arm of said rocker; said rocker having a recess between said arms so that the axis of said element and the axis of said rocker may be substantially coaxial when said element is in engagement with both of said arms; and means operable from the external end of said member for holding said element in adjusted position."

On January 12, 1939, Leishman disclaimed claim 5 of the reissue patent.

On November 10, 1939, Leishman filed a qualified disclaimer reading as follows:

"Hereby disclaims from the scope of claim 8 of said Letters Patent all structure except that in which the rocker is so constructed that it may act as a common follower for a plurality of such recited movable means; and

"Disclaims from the scope of claim 9 of said Letters Patent all structure except that in which the positioning element is so adjustably mounted that it may be fixed and maintained in its adjusted position irrespective of repeated operations of said operating means; and

"Disclaims from the scope of claim 10 of said Letters Patent all structure except that in which the positioning element is so adjustably mounted that it may be fixed and maintained in its adjusted position irrespective of repeated operations of said operating member."

One purpose of the patented device is to provide an apparatus for simultaneously turning one variable condenser to bring in a radio broadcast and a second variable condenser to bring in a television broadcast. Such a device embraces a pair of rotatable rockers, one connected with the radio and the other with the television condenser shaft. Each rocker is movable by a corresponding tappet frictionally clamped in a predetermined position on a lever assembly. Each tappet is mounted on a pivot so that it can be adjusted to different angular positions. One end of the lever assembly is pivoted on a shaft. When the lever is depressed, one side of each tappet engages an arm of its corresponding rocker and rotates that rocker until both arms of that rocker are in full engagement with both sides of its corresponding tappet, thus bringing each rocker to a position of rest. It will be observed that the position to which the tappet is adjusted determines the point at which the rocker comes to rest and the wave length to which the condenser is tuned, and that by one movement of the lever, each condenser is brought into a predetermined position. Adjustment is effected by loosening a wing nut on a setscrew mounted on the lever and extending through a recess in the tappet, depressing the lever, manually moving the condenser and its corresponding rocker to a desired predetermined position, moving the tappet into an angular position so that each of its sides is in complete engagement with its corresponding rocker arm, and then tightening the setscrew so as to hold the tappet in such angular position.

There is a recess in each rocker between the two opposite arms thereof. Each tappet has a projecting portion through which its pivot extends. When the lever is depressed, that portion of the tappet through which its pivot

extends moves into the recess in the rocker, and the axis of the tappet and the axis of the rocker become coaxial. This coaxial relationship is important because it insures accuracy at the time of the adjustment of the tappet. When each side of the tappet is brought into engagement with its corresponding arm of the rocker, the latter having been set at a predetermined and desired position, with coaxiality between the axis of the tappet and the axis of the rocker, pressure on the lever to hold the tappet in engagement with the rocker while the setscrew is being tightened will not result in movement of the rocker. Absent such coaxiality, pressure on the lever bringing the tappet into full engagement with the rocker, when the latter is in certain angular positions, would have a tendency to move the rocker.

The alleged infringing device employs a metal bar in the form of a plunger to which an adjustable tappet is attached. The plunger moves in guides. It carries a setscrew by which the tappet can be loosened for adjustment and held rigid at a desired angular position. As the plunger moves forward, one side of the tappet engages the rocker and rotates it until each side of the tappet is in engagement with its corresponding rocker arm. There is a recess in each rocker between the two opposite arms thereof. Each tappet has a projecting portion through which its pivot extends. When the plunger is pushed forward, the pivot of the tappet moves into the recess in the rocker and when each side of the tappet is completely engaged with its corresponding rocker arm, the axis of the tappet is substantially coaxial with the axis of the rocker. Movement of the shaft of the rocker is communicated by ratchet gears to the shaft upon which the movable condenser plates are mounted. By moving the plun-

ger forward, the tappets engage and move the rotatable rocker shaft which, in turn, by means of the ratchet gears, turns the condenser shaft and thus adjusts the condenser to the wave length of a desired station.

In *Leishman v. Associated Wholesale Electric Co.*, 36 F. Supp. 804, the court adjudged claims 7 to 11, inclusive, invalid for want of invention. On appeal, the Ninth Circuit held that if claims 7 to 11, inclusive, did not include levers, they were not for the same invention as the original patent and were, therefore, invalid, and that if they did include levers, the plungers and the levers not being mechanical equivalents, such claims were not infringed by an accused device which contained no lever, and concluded it was not necessary to pass on the validity of claims 7 to 11, inclusive.³

There, as here, the alleged infringing device employs only one rocker and one set of corresponding tappets, and

³See *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, 727, where the court said:

"These claims, it will be observed, are for combinations each of which includes a rocker. Whether the combinations include tappets and levers is not clear. If they do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.

"The accused device (a mechanical tuner for a radio receiving set) is manufactured by the Crosley Radio Corporation and sold by appellee. It has a rocker which is the equivalent of appellant's rocker 48. It has no rocker 54 nor any equivalent thereof. It has tappets each of which is the equivalent of appellant's tappet 61. It has no tappet 62 nor any equivalent thereof. It has no lever of any kind or character. Its tappets are operated (made to engage the rocker) by means of plungers. The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66. The part so performed is not performed in the same way, or in substantially the same way. Hence the plungers and the levers are not equivalents."

the tappets are mounted on and moved by plungers, not levers.

However, claims 7 to 11, inclusive, embrace a single rocker and corresponding adjustable tappets mounted on pivots, means for moving each tappet so one of its sides engages one arm of the rocker and rotates the rocker until the other side of the tappet engages the other arm of the rocker, and they do not specifically embrace a lever means for carrying and moving the tappets; and we are unwilling to rest our decision on the narrow ground that the lever in the device of the patent in suit and the plunger in the accused device are not mechanical equivalents.³

The use of levers and adjustable tappets mounted thereon to rotate rockers was well known in the art when Leishman entered the field. The prior patent to Marschalk, No. 2,072,897, granted March 9, 1937, discloses a lever assembly, an adjustable tappet pivotally mounted thereon, and a rocker, the shaft of which communicates by ratchet gears with a shaft on which movable radio condensers are mounted, so arranged that by depressing the lever, the rocker will be rotated by the tappet to a predetermined position to which the tappet has been adjusted, and the rotation of the rocker will, in turn, rotate the condenser shaft so as to tune the radio to a desired wave length. Marschalk, however, does not disclose the

³Cf. *Steiner Sales Co. v. Schwartz Sales Co.*, 10 Cir., 98 F. 2d 999, 1012.

See Walker on Patents, Deller's Ed., Vol. 3, p. 1706, §468.

element of coaxiality of the axis of the tappet and the axis of the rocker embraced in claims 8, 10, and 11. It is clear, therefore, that claims 7 and 9 are anticipated by Marschalk and that claims 8, 10, and 11 are likewise anticipated by Marschalk, unless the adding to the combination disclosed by Marschalk of the element of coaxiality amounted to invention over Marschalk. The principal of coaxial relationship and its importance, where it is desired that two parts of a machine operate together harmoniously, has been within the knowledge, for many years, of ordinary mechanics skilled in their art.

In order to rise to the dignity of invention, the conception of a patent must be the result of the exercise of the inventive or creative faculty, not of mere mechanical skill.⁴

Mechanical skill is but the display of the expected skill of the calling; it involves only the exercise of the ordinary faculties of reasoning, aided by the special knowledge and the facility of manipulation which is acquired through habitual and intelligent practice of the art and it is in no sense the creative work of that inventive faculty which it is the purpose of the Constitution and the patent laws to encourage and reward.⁵

⁴Callison v. Boyle, 10 Cir., 95 F. 2d 575, 576;
Turner v. Goldstein, 10 Cir., 154 F. 2d 338, 341.

⁵Callison v. Dean, 70 F. 2d 55, 58;
Hollister v. Benedict & Burnham Mfg. Co., 113 U. S. 59, 73.

That which would readily appear to one acquainted with the prior art and skilled in that art involves merely mechanical skill.*

Here, we think, the desirability of having the axis of the tappet and the axis of the rocker coaxial, when the tappet is in full engagement with the arms of the rocker, and the necessary changes in Marschalk's device to effect that result, would readily occur to one acquainted with the prior art and skilled in that art and would involve the exercise of mere mechanical skill.

We conclude, therefore, that claims 8, 10, and 11 did not constitute invention over Marschalk and that all of the claims in suit were anticipated by Marschalk.

The judgment is REVERSED and the cause REMANDED with instructions to enter a decree adjudging the claims in suit invalid for want of invention.

*Callison v. Dean, 10 Cir., 70 F. 2d 55, 58;

Id. 10 Cir., 95 F. 2d 575, 576;

Turner v. Goldstein, 10 Cir., 154 F. 2d 338, 341.

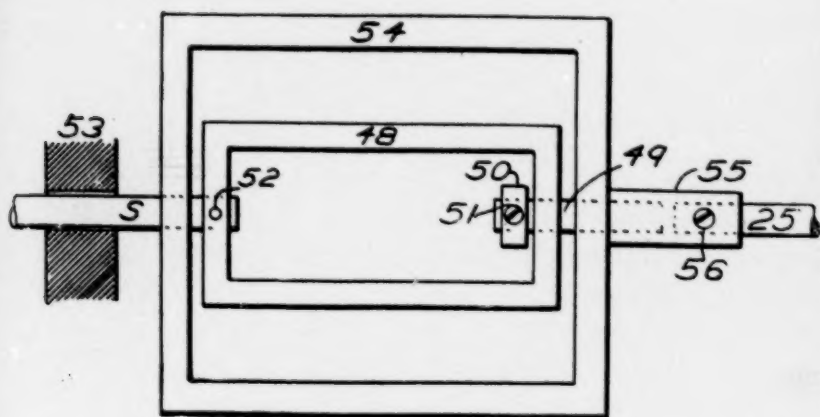


Fig. 1

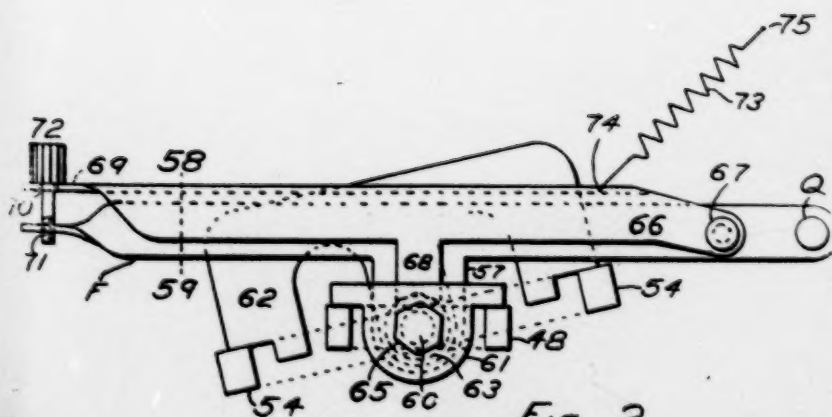


Fig. 2